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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,110	02/25/2004	Yusaku Yamamoto	NITT.0193	8797
7590 09/25/2008				
Stanley P. Fisher Reed Smith LLP Suite 1400 3110 Fairview Park Drive Falls Church, VA 22042-4503			EXAMINER NGO, CHUONG D	
			ART UNIT 2193	PAPER NUMBER
			MAIL DATE 09/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,110

Applicant(s)

YAMAMOTO ET AL.

Examiner

Chuong D. Ngo

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The abstract of the disclosure is objected to because the abstract is not within the range of 50 to 150 words. Correction is required. See MPEP § 608.01(b).

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 11-16 are directed under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11-16 are directed methods and a computer for merely performing calculations and manipulations of data. In order for such a claimed invention that merely performs calculations and manipulations of data to be statutory, the claimed invention must accomplish a practical application, and is not directed to a preemption of a calculation and/or manipulation data. That is the claimed invention must transform an article or physical object to a different state or thing, or produce a useful, concrete and tangible result and not cover every substantial practical application. See *State Street* 47 USPQ2d, *Benson* 175 USPQ, and “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility”, OG Notices: 22 November 2005. It is clear from claims 11-16 that the claimed method merely involve in calculations and manipulations of data to transform a set of numbers to a not the set of numbers. They do not transform an article or physical object to a different state or thing. The input are numbers and the output are also number. Further, since the claims fail to recited a practical application for the invention, the result produced by the data calculations and

manipulations of the claimed does not have a real world besides a mere set of numbers, and thus is not useful, concrete and tangible. Therefore, claims 11-16 are directed to non-statutory subject matter as the claimed invention fails to accomplish a practical application. Further, since the claims fail to limit the invention to a practical application, they appear to cover every substantial practical application, and thus are also directed to a preemption of the claimed manipulations and calculations of data.

4. Applicant's arguments filed on 07/15/2008 have been fully considered but they are not persuasive.

It is respectfully submitted since the claims are clearly directed an invention that merely performs calculations and manipulation of data, such invention is required to accomplish a practical application and not to preempt of a calculation and/or manipulation data to be statutory. That is the claimed invention must transform an article or physical object to a different state or thing, or produce a useful, concrete and tangible result, and not cover every substantial practical application. However, none of the requirements is met by the claimed invention. The claimed invention, as applicant argued, may improve a computation in some aspects relative to some other method or computer, it does not transform an article or physical object to a different state or thing, or provide a useful, concrete and tangible result since the result produced by the claimed invention is not a real world result, but a mere set of numbers. It should be noted that in State Street, the claims clearly recite a practical application "for managing a financial services configuration of a portfolio established as partnership" for the claimed data processing system to produce a useful, concrete and tangible result as clearly having a real world value --a final share

price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades, and in re Alappat, the claims clearly recite a practical application for the computation “for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means”, to produce useful, concrete and tangible result, that is “anti-aliased pixel illumination intensity data to be displayed on a display means” as a smooth waveform. On the other hand, claims 11-16 fail to recite a practical for the invention to produce a useful, concrete and tangible result. Therefore, the claimed invention produces a result merely numbers indicating a result of a calculation and having no real word value, and thus fails to produce a useful, concrete and tangible result.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuong D. Ngo whose telephone number is (571) 272-3731. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis, Jr. A. Bullock can be reached on (571) 272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chuong D Ngo/
Primary Examiner, Art Unit 2193

08/22/2008